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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,915	01/17/2001	Yasuo Tano	4084-2163	5564
21888	7590	06/06/2006	EXAMINER	
THOMPSON COBURN, LLP ONE US BANK PLAZA SUITE 3500 ST LOUIS, MO 63101			BUI, VY Q	
			ART UNIT	PAPER NUMBER
			3734	

DATE MAILED: 06/06/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/761,915  
Filing Date: January 17, 2001  
Appellant(s): TANO ET AL.

**MAILED**  
**JUN 06 2006**  
**GROUP 3700**

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Joseph M. Rolnicki  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 01/28/2005 appealing from the Office action mailed 07/19/2004.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

5,118,291

Varaine

6-1992

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 26 is rejected under 35 U.S.C. 102(b). This rejection is set forth in a prior Office Action, mailed on 7/19/2004.

Claims 1, 3-4, 7, 9-15 and 21-27 are rejected under 35 U.S.C. 251. This rejection is set forth in a prior Office Action, mailed on 7/19/2004.

**(10) Response to Argument**

As to the rejection of claim 26 under 35 U.S.C. 102(b), the Applicant argued that Varaine-'291 device and the device of the present invention have different intended uses and Varaine-'291 device does not have fine grains on the tip (Remarks filed 1/28/2005, page 9, lines 9-11).

However, Varaine-'291 (Fig. 1-6; abstract, lines 10-17; claim 1, col. 4-col. 5) discloses an instrument structured as recited in the claim, especially fine grains/micrograins located on a tip of the Varaine-'291 device. The language in claim 26 has failed to point out any structural difference between the present invention device and Varaine-'291 device. Further, in a device claim, the difference in the intended uses of the Varaine-'291 device and the device of the present invention cannot be given much patentable weight when there is no structural difference between the claimed invention and Varaine-'291 device. Therefore the present claimed invention should be rejected over Varaine-'291 device as set forth in the previous final "Office Action".

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As to the rejection of claims 1, 3-4, 7, 9-15 and 21-27 under 35 U.S.C. 251, the Applicant admitted that the independent claim 1 of the parent case 09/058,183 was amended to include "a hollow tapered tip" and "said grains are located in a range of 0.5mm to 3.0mm from an end portion of said front tip" after a rejection applied over reference U.S. Patent Shimizu-3,809,101, but argued that **there is no (emphasis added) mention** of the specific 0.5mm to 3.0mm range in the prosecution history that the specific range 0.5mm to 3.0mm was added to claim 1 to distinguish the subject matter claimed from Shimizu-'101 (please see section (8) Argument of the "Appeal Brief" filed 1/28/2005).

However, in "Amendment and Remarks" of paper 6/a received on February 05, 1999 by U.S. PTO in the prosecution history of the parent case 09/058,183 (please see attachment with this "Examiner Answer" for reference), the "Amendment" and especially "Remarks" sections, line 13, page 5 to line 4 page 6, the Applicant argued that:

"Considering first then the rejection of Claim 1 and 4 under 35 U.S.C; §102 as being anticipated by Shimizu, it is noted that Claim I has been properly amended so as to be more closely directed to a membrane eraser used for ophthalmic surgery. More particularly, the membrane eraser is claimed as including an elastic body having **a hollowed tapered front tip in combination with a plurality of hard inorganic fine-grains fixed on a tapered front tip of the elastic member where the grains are located in a range of 0.5 mm to 3.0 mm from a tip-end portion of the front tip**. This is clearly distinguished from the nail file filing an individual's nails as shown in Shimizu which neither comprises a hollow tapered front tip of an elastic body nor does the same teach **limiting the location of the grains to the range presently claimed** and instead teaches only the utilization of an abrasive sheet 9 which extends substantially the entire

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length of the holding member of two connecting portions 6, as best illustrated in each of Figures 2B and 3B thereof. In view of the foregoing, it is respectfully submitted that Claim 1 clearly patently defines over the Shimizu and that Claim 4, based both upon the limitations set forth therein and based upon the dependency of Claim 4 from Claim I, also merits indication of allowability.”

After review the above argument, the Examiner found no motivation to modify Shimizu nail file to have grains in the above range as amended in claim 1 and the above argument provided good reasons to allow the case, therefore, claim 1 of parent case was allowed and the application was issued as U.S. Pat. 5,921,998.

It has been clear to the Examiner that the Applicant have relied on both features “hollow tapered front tip” and “grains are located in a range of 0.5mm to 3.0mm from an end portion of said front tip” presented in amended claim 1 of parent case 09/058,183 to distinguish the present invention over Shimizu reference.

Therefore, an exclusion of these two features from any independent claim in the present reissue application is considered as an attempt to recapture the two features, which have been surrendered during prosecution of the parent case 09/058,183.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Vy Q. Bui  
Primary examiner  
AU 3734

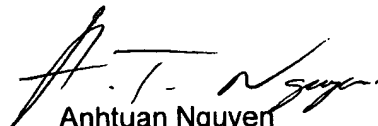
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